

REMARKS

Claim 1-14 are currently pending in the subject application. Reconsideration of the application in its current format is respectfully requested.

The Examiner has rejected claims 1 and 8 under 35 U.S.C. §103(a) as being unpatentable over German Patent Document DE1265836 to Peiser et al. (hereinafter "Peiser"), in view of U.S. Patent No. 4,794,948 to Schempp (hereinafter "Schempp"). The Examiner has rejected claims 2-5 under 35 U.S.C. §103(a) as being unpatentable over Peiser in view of Schempp, as applied to claim 1, and further in view of U.S. Patent No. 3,467,903 to Streater (hereinafter "Streater"). The Examiner has rejected claims 6-7 and 9-10 under 35 U.S.C. §103(a) as being unpatentable over Peiser in view of Schempp, as applied to claims 1 and 8, and further in view of U.S. Patent No. 5,939,839 to Robel et al. (hereinafter "Robel"). The Examiner has rejected claims 11-14 under 35 U.S.C. §103(a) as being unpatentable over Peiser in view of Schempp and Robel, as applied to claim 10, and further in view of Streater. Applicant traverses these rejections for at least the reasons set forth below. For purposes of brevity, Applicant will not repeat the arguments made in its Amendment "B", but hereby incorporates them by reference.

In the final office action, the Examiner states that he did not rely on the PTC resistor 24 of Schempp in rejecting the claims, but instead relied on the PTC resistor 21 of Schempp. The reference numeral "21" used in Fig. 1 to designate the PTC resistor is clearly erroneous. In the specification and in Fig. 2 of Schempp, the PTC resistor is designated with the reference numeral "24". In the specification and in both Figs. 1 and 2, the reference numeral "21" is used to designate an output terminal. Thus, the reference numeral "21" is improperly used twice in Fig. 1 of Schempp for two different elements: once (correctly) for the output terminal and once (incorrectly) for the PTC resistor.

In maintaining his rejection of the claims in the final office action, the Examiner states:

"[T]he motivation to modify the protective switching device of Peiser et al. with the protective circuit as taught by Schempp, is to provide a reliable and more sensitive overcurrent fault protection circuit. Peiser et al. overcurrent switching devices including relay contacts (rr, rs, rt) which has a disadvantage of becoming mechanical worn out from opening and closing during overcurrent faults."

The Examiner has not provided any support for his assertion that the circuit of Schempp would work better than the relays RR, RS, RT. This is pure speculation on the part of the Examiner. More importantly, however, the relays RR, RS, RT and their contacts rr, rs, rt are the heart of the invention of Peiser. Thus, replacing these relays with the circuit of Schempp would change the principle of operation of the invention of Peiser. Pursuant to established patent law, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In addition to the foregoing, the Examiner has not provided any reasoning why one skilled in the art would use the LED 23 of Schempp in the power system of Peiser. The purpose of the LED 23 in Schempp is to provide indication for a directional control valve, as is conventional (see column 1, lines 9-11). What purpose would be served by using the LED 23 in the power system of Peiser?

For at least the foregoing reasons and the reasons previously set forth in Amendment "B", Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness in rejecting the pending claims. Accordingly, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Respectfully submitted,

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